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10/816,251

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Gregory J. Wolff

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EXAMINER

BELOUSOV, ANDREY

ART UNIT

PAPER NUMBER

2174

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/816,251	<b>Applicant(s)</b> WOLFF ET AL.	
	<b>Examiner</b> ANDREY BELOUSOV	<b>Art Unit</b> 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to the amendment of 11/25/2008. Claims 1-52 are pending and have been considered below.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, 10, 15, 19, 24, 25, 29, 30, 31, 33, 34, 37, 38, 41, 44, 49, 50, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ballantyne, et al. (5,867,821.)

**Claim 1, 19, 31, 38:** Ballantyne discloses a method comprising:

- a. representing a first collection (e.g. patient record) of media objects (e.g. charts, data entry forms, medical forms) using a first sheet (e.g. touch panel; 10:23-27) having a first graphical content representing the media objects (10:10-27),
- b. wherein the first sheet is a cover sheet that provides access to the first collection of the media objects (9:54-59);
- c. creating a second collection of media objects from the first collection of media objects (entering information in the forms, notes, etc; 10:10-27); and
- d. re-marking the first sheet that includes writing (14:23-26) a second graphical content representing the second collection of media objects (updating patient's

Art Unit: 2174

medical record; 10:10-27) onto the first sheet, such that the second graphical content is presented on the first sheet in a non-electronic form (11:29),

- e. wherein the re-marked first sheet including the second graphical content in the non-electronic form (11:29) provides access to the second collection of the media objects (9:54-59.)

**Claim 9, 24, 33:** Ballantyne discloses the method defined in claim 1 further comprising accessing the first collection using a first identifier, wherein the first identifier comprises a machine-readable identifier (e.g. bar code; 13:57-59; 12:15-24.)

**Claim 10, 25, 34, 41:** Ballantyne discloses the method defined in claim 9 wherein the machine-readable identifier comprises a barcode (13:57-59.)

**Claim 14:** Ballantyne discloses the method defined in claim 1 wherein the first sheet comprises a medical information of a patient (10:10-27.)

**Claim 15, 29, 30, 37, 44:** Ballantyne discloses the method defined in claim 14 wherein the first collection of media objects comprises patient objects regarding a patient, and further wherein the second collection of media objects represents an updated version of the patient objects for the patient (10:10-27.)

Art Unit: 2174

**Claim 49:** Ballantyne discloses the method defined in claim 48 further comprising determining a difference between representations for the first and second collections; and erasing a portion of the sheet based on the difference between the representations of the first and second collections (updating patient's medical record; 10:10-27.)

**Claim 50:** Ballantyne discloses a method comprising:

- a. erasing a portion of the sheet having a non-electronic (11:29) representation of a collection of media objects, wherein the representation includes a first graphical content to represent the media objects (updating patient's medical record; 10:10-27) in a non-electronic form (11:29),
- b. wherein the sheet is a cover sheet including the first graphical content in the non-electronic form (11:29) that provides access to the collection of the media objects (9:54-59); and
- c. marking the portion of the sheet with updated information (Fig. 11D: 436) that includes writing a second graphical content onto the sheet in a non-electronic form (14:23-26; 11:29.)

**Claim 52:** Ballantyne discloses the method defined in claim 50 further comprising scanning the portion of the sheet, prior to erasing, to obtain scanned information, and wherein the updated information is based on the scanned information (6:20-31; Fig. 11D.)

Art Unit: 2174

Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Sellen et al. (2002/0052888.)

**Claim 46:** Sellen discloses a method comprising:

- a. determining whether a document is erasable that includes
- b. scanning a portion of the document (Fig. 5: 86) to obtain first scanned data (Fig. 5: 90); storing the first scanned data in a memory (Fig. 5: 92);
- c. wherein the portion of the document includes a content in a non-electronic form (11:29);
- d. performing an erasing operation on the scanned portion of the document that includes the content in the non-electronic form (11:29) at the location of the portion (0036 – revising the document);
- e. scanning the erased portion of the document to obtain second scanned data (Fig. 5:84-94; 0035); and
- f. determining whether the document is erasable based on the first and second scanned data (it is an inherent determination, given that the document can be altered, including to a blank page; Fig. 5:52-62.)

2. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by Geeslin (2002/0064113.)

**Claim 47:** Geeslin discloses a method comprising:

- a. detecting a writable mark (Fig. 1D: protection state byte) when scanning a re-writable paper (par. 32, 33);
- b. wherein the writable mark includes a shape (inherent pattern or pits and lands that encodes the raw data on a CD) placed on the re-writable paper in a non-electronic form (mechanical form; optical disk: Fig. 1A);
- c. preventing modification to the re-writable paper that includes preventing from printing on the re-writable paper in response to detecting the writable mark (par. 5; Abstract.)

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-8, 12, 13, 20-23, 32, 27, 28, 36, 39, 40, 42, 43, 45, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Kashiwagi et al. (6,396,598.)

**Claim 2, 20, 32, 39, 48:** Ballantyne discloses the method defined in claim 1, further comprising:

- a. erasing the first sheet (13:11-27); and

- b. adding one or more other media objects to the first collection of media objects to create the second collection of media objects (updating: 13:11-27);

However, Ballantyne does not explicitly disclose:

- c. scanning a first identifier on the sheet; and
- d. marking the first sheet with a second identifier to identify the second collection and the second graphical content.

Kashiwagi discloses a method for using an electronic memo apparatus to handle electronic documents, comprising:

- a. scanning a first identifier on the sheet (11:19-44); and
- b. marking the first sheet with a second identifier to identify the second collection and the second graphical content (17:33-42.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the scanning of an identifier with marking of a second identifier upon creation of a second collection, as taught by Kashiwagi to the disclosure of Ballantyne. One would have been motivated to scan an identifier on the sheet, and then mark it with a second identifier to identify the second collection so as to determine document information for editing and display purposes (11:39.)

**Claim 3:** Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein the media objects are scanned pages (6:27-31.)



Art Unit: 2174

**Claim 4:** Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein the media objects are electronic documents or images from a digital memory card (electronic medical records: Abstract; 10:50.)

**Claim 5:** Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein marking the first sheet comprises identifying open areas on the sheet based on scanned information and determining where to mark the sheet based on the open areas (“data entry forms”: 10:15.)

**Claim 6, 22, 40, 43, 45:** Ballantyne and Kashiwagi disclose the method defined in claim 2. Kashiwagi further discloses further comprising: accessing the first collection of media objects using the first identifier (12:15-24); and scanning the one or more pages of the one or more other media objects (14:53-64.)

**Claim 7, 21, 36:** Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein the first identifier and the second identifier are identical (document identifier: 11:60-67; Fig. 7.)

**Claim 8, 23:** Ballantyne and Kashiwagi disclose the method defined in claim 2. Ballantyne further discloses wherein re-marking the first sheet comprises identifying open areas on the sheet based on scanned information and determining where to mark the sheet based on the open areas (“data entry forms”: 10:15.)

**Claim 12, 27:** Ballantyne discloses the method defined in claim 1. Ballantyne does not disclose wherein

- a. re-marking the first sheet only occurs in a first mode of operation, and further comprising
- b. marking a second sheet with the second graphical content in a second mode of operation, where the second mode is different than the first mode of operation.

Kashiwagi discloses a method for using an electronic memo apparatus to handle electronic documents wherein

- a. re-marking the first sheet only occurs in a first mode of operation, and further comprising
- b. marking a second sheet with the second graphical content in a second mode of operation, where the second mode is different than the first mode of operation  
(Fig. 14: 222-230.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the first and second modes of marking first and second sheets, as taught by Kashiwagi to the disclosure of Ballantyne. One would have been motivated to first and second modes of marking first and second sheets so as to encompass numerous common media formats that may be incorporated on the sheets  
(11:39.)

Art Unit: 2174

**Claim 13, 28:** Ballantyne and Kashiwagi disclose the method defined in claim 12.

Ballantyne further discloses wherein marking the second sheet with the second graphical content occurs while erasing the first sheet (updating: 13:11-27.)

**Claim 42:** Ballantyne and Kashiwagi disclose the method defined in claim 39.

Kashiwagi further discloses further comprising a scanned sheet feeder coupled to the scanner to send the sheet to the erasing unit if the sheet is re-writable (Fig. 1: 62.)

5. Claims 11, 26, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Cardullo et al. (3,713,148.)

**Claim 11, 26, 35:** Ballantyne discloses the method defined in claim 9. However, Ballantyne does not disclose wherein the first identifier comprises a radio frequency identifier (RFID). However, Official notice is taken that RFID technology is old and well known in the arts (for example, as taught by Cardullo, 3,713,148,) and therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to use RFID as identifiers. One would have been motivated to use RFID tags as they require no internal power, are relatively small in size and are portable (2:30-64.)

6. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Ludtke et al. (6,260,063.)

Art Unit: 2174

**Claim 16:** Ballantyne discloses the method defined in claim 1. Ballantyne does not further explicitly disclose marking the sheet with a machine-readable indicator that indicates that the sheet is not to be erased. However, Official Notice is taken that it is old and well known in the computing arts to have a write-protection mechanism for electronic documents, such as disclosed in Ludtke (7:34-64.) Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a write-protection mechanism as taught in Ludtke to the disclosure of Ballantyne. One would have been motivated to combine the teaching of Ludtke to that of Ballantyne so as to provide a form of protection against inadvertent deletion / erasure of important documents.

**Claim 17:** Ballantyne and Ludtke disclose the method defined in claim 16. Ludtke further discloses wherein the indicator is erasable (i.e. flag can be set / removed; 7:34-64.)

**Claim 18:** Ballantyne and Ludtke disclose the method defined in claim 16. Ludtke further discloses wherein the indicator is one of a predetermined shape, pattern, or color (7:34-64.)

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al., in view of Sellen et al. (2002/0052888.)

Art Unit: 2174

**Claim 51:** Ballantyne discloses the method defined in claim 50. However, Ballantyne does not explicitly disclose wherein the updated information comprises a timestamp. Sellen teaches a method for an electronic record storage wherein updated information comprises a timestamp (Abstract.) Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to update the timestamp upon a updating of the sheet. One would have been motivated to update the timestamp of the sheet to know whether the sheet is up-to-date and accurate (0004.)

### ***Response to Arguments***

7. Applicant's arguments filed April 8, 2008 have been fully considered but they are not persuasive.
8. Applicant's argument that "Ballantyne fails to disclose the sheet including graphical content in the non-electronic form" has been fully considered but is not persuasive. Ballantyne discloses the use of Liquid Crystal Display, which utilizes photons (as opposed to electrons) to present information in a photonic form.
9. Applicant's argument with respect to claim 47, that Geeslin does not "wherein the writable mark includes a shape placed on the re-writable paper in a non-electronic form" has been fully considered but is not persuasive. Given the broad definition of the terms "paper", "paper medium", "sheet" and "printing" in the application:

The terms "paper," "paper medium," or "sheet" as used in this application are intended to refer to any tangible medium on which information can be formed whether by a printing process, written, drawn, imprinted, embossed, etc. For purposes of this invention, the term "printing" is intended to encompass all manner of forming images on an image-bearing medium whether by optical,

Art Unit: 2174

mechanical, thermal, or electrical methods, or combinations thereof. (par. 26, PGPub.)

Geeslin discloses the 'shape' as bytes that are written on the 'paper', which given the definition above would encompass the optical medium (which is non-electronic) of Geeslin.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Belousov whose telephone number is (571) 270-1695. The examiner can normally be reached on Mon-Fri (alternate Fri off) EST.

Art Unit: 2174

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven P Sax/  
Primary Examiner, Art Unit 2174

AB  
March 11, 2009